

Appl. No.: 10/678,947

REMARKS

The Examiner contends that there are multiple inventions, too many to list individually, contained in the instant application. The Examiner has, however, indicated that an election must be made between one of the following groups of inventions:

Group I Claims 1-14, drawn to products of the formula (IV), classified in various subclasses of classes 514, 544, 546, 548 and 549

Group II Claims 15-20 drawn to methods of use for the compounds of the formula (IV), classified in various subclasses of class 514.

Applicants elect to pursue Group I at this time, reserving the right to pursue the subject matter of Group II without prejudice at a later time.

The Examiner has also required an election of a single compound within Group I, including an exact definition of each substitution of the base molecule (Formula IV). The Examiner states that upon such an election the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound. This scope will be explained or presented in the first Office Action on the merits. The Examiner also states that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with the process of using or making said compound, if appropriate.

Applicants elect to pursue the compound benzofuran-2-carboxylic acid (3 methyl-1S-(2R-methyl-4-oxo-tetrahydro-furan-3S-ylcarbamoyl)-butyl)amide, as appearing on page 88 line 17 of the Specification. Applicants traverse, however, the point at

Appl. No.: 10/678,947

which the restriction will be made final.

Typically, an Office Action requiring restriction presents the full extent of the restriction groups, affording the applicant an opportunity to argue against the construction of the restriction classes or against the restriction altogether. In the present situation, Applicants are requested to select a compound upon which a restriction group can be formed, but the extent of that restriction group remains, at this point, unknown.

The Examiner's statements that the scope of the restriction group will be presented in the first Office Action on the merits and that it will, apparently, also be made final at that time is a significant departure from standard USPTO procedure. The process presented by the Examiner unfairly removes Applicants' rights to argue against the restriction because it is presently unclear what is encompassed by the restriction group. Yet the Examiner's description of events also precludes argument once the content and scope of the restriction group is revealed.

In view of the above, Applicants respectfully request reconsideration and that the restriction requirement not be made final until Applicants have had an opportunity to present any arguments they believe appropriate.

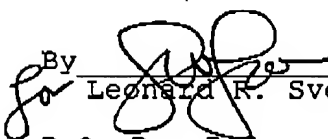
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Susan W. Gorman (Reg. No. 47,604) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No.: 10/678,947

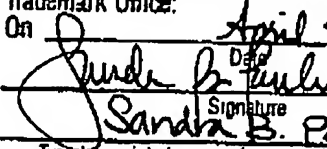
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #47,604
for Leonard R. Svensson, #30,330
P.O. Box 747
Falls Church, VA 22040-0747
(714) 708-8555

LRS/SWG
1718-0208P

Outside of Transmission
I hereby Certify that this correspondence is being
facsimile transmitted to the Patent and
Trademark Office:
On  April 4, 2006
Date
Signature
Sandra B. Paulo
Typed or printed name of person signing certificate